



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,084	01/08/2001	James H. Waldo	06502.0110-01	6895

22852 7590 07/07/2003

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

GECKIL, MEHMET B

ART UNIT	PAPER NUMBER
----------	--------------

2142

12

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,084

Applicant(s)

WALDO ET AL.

Examiner

Mehmet B. Geckil

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-9, 11. 6) ☐ Other: _____

1. Claims 8-39 are presented for examination. Preliminary amendment was partially entered, i.e., claim 1 was canceled. Application was filed with original claims 1-39. Therefore, could not add new claims 8-39 as requested in the preliminary amendment because claims 8-39 was already in the application. Examiner cannot locate IDS Number 10 submitted to the Office on 10/21/2002. Applicant should submit the IDS in response to this Office action so that examiner can consider it.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure.

Base claim 25 recites only a single step and thus encompasses all possible step for performing a desired function and disclosure does not support performing all possible steps (e.g., see MPEP 706.03(c) and 2164.08 (a) Single Means Claim.)

3. Claim 25 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Art Unit: 2142

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 8-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pal et al.

7. Pal et al (6,219,675) taught the invention substantially as claimed (e.g., exemplary claim 1) including a database data processing system having a lookup service or database service with associated services, e.g., query service available for use in the data processing system, comprising a navigational agent sending a callback message to a client computer where the callback message requesting a response when the client completed processing (e.g. updating) with a particular database object (col 5, line 23 et seq; col 6, line 57 et seq; and col 7, line 1 et seq.) It would have been obvious

to one of ordinary skill in the networking and database art at the time of the invention that the claimed invention differed from the teachings of Pal et al only by a degree, e.g. in the claimed lookup service and requesting notification particulars. It is well known to one skill in the art that lookup service as referred in the claims is an obvious variation of the database because databases are used for lookup services or for query services. The meaning of lookup and query are synonymous. For example, everyone knows how to use Yaahoo and enter a query regarding a person's name or a zip code to receive whether information corresponding to the zip code location. Yahoo looks it up from its database and responds with the matching answer. Moreover, it is well known in the telephone services art to use lookup services of the telephone numbers for decades. Applicant is broadly claiming that when a lookup service is updated, the requesting client should be notified but this is exactly an obvious variation of Pal et al teaching of the callback message requesting a response when the client completed processing. All other variations of notification according to when or while the update occurs are all obvious variations of Pal et al teachings.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carpenter (6,199,068) taught registering callback functions with TRAN to determine when transactions are prepared, aborted, and committed. It also registers with the "threadTid" module to be notified when a new transaction is present (col 14, lines 40-52.) Obviously applicant's claimed lookup service and notification upon an update to

Art Unit: 2142

the lookup service is an obvious variation of Carpenter's teachings as references hereinabove. This reference could be used to write up a rejection but since Examiner already had the Pal et al rejection, Examiner only wanted to make a record of his teachings so that the applicant is put to notice and appreciate how strong the Carpenter's teachings are against the claimed invention.

Mack (6,192,044) taught a request service application querying a lookup service (col 4, line 20 et seq.)

Fahrer et al (6,078,655) taught lookup service for other services subscribed (col 6, line 59 et seq.)

Nelson (6,058,381) taught using general lookup services on the network, e.g., Yahoo, (col 13, lines 27 and 40.)

Govett (5,761,507) taught portmapper providing a registration service for each server in response to a request and also providing a lookup service for clients (col 4, line 49 et seq.)

Gardner et al (5,754,977) taught providing lookup services and results (col 5, line 27 et seq.)

Miller (5,506,984) taught using a callback procedure to update the database (columns 11-13.)

Lewis et al (5,303,042) taught a user task registering callbacks in a callback table for notification (see Figure 8, and its corresponding explanation in col 14.)

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehmet Geckil whose telephone number is (703) 305-9676. The examiner can normally be reached on Monday through Friday from 6:30 A.M. to 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mark Powell, can be reached on (703) 305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are listed hereinbelow.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700. Customer service number is (703) 306-5631.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7238 (for After final communications);

Or:

(703) 746-7239 (for formal communications intended for entry)

Or:

(703) 746-7240 (for status inquiry or informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

6/27/03

MEHMET B. GECKIL
PRIMARY EXAMINER

Mehmet B. Geckil